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Raymond Y Chan  
Suite 128 108 N Ynez Avenue  
Monterey Park, CA 91754

EXAMINER

SNAPP, SANDRA S

ART UNIT PAPER NUMBER

3624

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/733,409

**Applicant(s)**

HUI ET AL.

**Examiner**

Sandra Snapp

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

This Office Action is in response to the Amendment filed on 7-6-4. Currently, claims 1-29 are pending in the application. The amendment filed 7-6-4 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: digitally signed messages, as amended throughout the claims and specification. The specification previously only identified the security password and security code, there was no reference or previous recitation of the security password being *a digitally signed message*. Applicant is required to cancel the new matter in the reply to this Office Action. As such, the new matter was not treated in this response.

***Specification***

The disclosure was previously objected to because on page 5, line 11, the phrase "Referring to figs. 1 to 4" was incorrect since there are only 3 figures in the application. Such passage was amended in the Amendment of 7-6-4 and the objection is herein withdrawn.

***Claim Objections***

The objection to claims 2, 14 and 16 have been successfully overcome, and such objections are herein withdrawn.

***Claim Rejections - 35 USC § 112***

The rejections of claims 14, 16 and 22 have been successfully overcome and are herein withdrawn.

***Claim Rejections - 35 USC § 102***

Claims 1-9, 14, 15, 22, 23, 26 and 27 remain and are finally rejected under 35 U.S.C. 102 as being anticipated by the Jalili patent (US 6,088,683).

The Jalili patent discloses a mobile payment system, comprising the steps of:

Receiving a payment request in an operation center from a registered merchant through a communication network (col. 2, lines 28-39),

requesting the registered merchant to inform a customer ID of a customer, who is a registered member of the operation center, and a transaction amount to be paid by the customer to the registered merchant (col. 1, lines 60-67),

verifying a merchant ID of the registered merchant by the operation center (col. 2, lines 28-39), confirming the payment request by the operation center by the notifying customer and requesting for verification (col. 2, lines 40-67),

requesting the customer to verify the payment transaction by confirming the transaction amount and inputting a security password of the customer registered in the operation center (col. 2, lines 40-48), and

confirming with the registered merchant whether the payment request is issued (col. 3, lines 1-6) (claim 1);

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Indicating to the registered merchant that the customer prefers to settle a payment through a mobile payment system when the customer decides to purchase one or more products from the registered merchant (col. 2, lines 8-14), and

initialing transaction by sending the payment request to the operation center by the registered merchant through a communication terminal (col. 2, lines 28-39) (claim 2);

Requesting the customer ID and the transaction amount by the operation center (col. 2, lines 40-67), and

entering the customer ID and the transaction amount to be paid to the registered merchant through the communication terminal (col. 2, lines 40-67) (claims 3 & 4);

Further transaction information is requested by the operation center, wherein the transaction information includes but is not limited to product code, transaction date and time, and identification of the registered merchant (col. 2, lines 28-39) (claim 5);

Receiving the customer ID and the transaction amount from the registered merchant by the operation center (col. 2, lines 28-39), and

verifying identity of the registered merchant by checking a merchant database by the operation center (col. 2, lines 28-39) (claims 6, 7, 8, 9);

Sending a notification message to the communication device of the customer to indicate the payment request (col. 2, lines 49-67), and

verifying the transaction amount and other transaction information with the customer (col. 2, lines 49-67) (claim 14); and

Requesting the customer to confirm the transaction amount and to enter the security password of the customer (col. 2, lines 40-48), and

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verifying the transaction amount and inputting the security password by the customer (col. 2, lines 40-48) (claim 15).

The Jalili patent also discloses a mobile payment system, comprising:

At least a communication terminal installed by a merchant registered in an operation center as registered merchant (col. 2, lines 40-67),

a communication network for connecting the communication terminal of the registered merchant with the operation center, the registered merchant is capable of submitting a payment request to the operation center, wherein after the operation center receives the payment request, the operation center is capable of requesting the registered merchant inform a customer ID of a customer, who is a registered member of the operation center, and a transaction amount to be paid by the customer to the registered merchant (col. 2, lines 40-67), and

a communication device, which is carried by the customer, connecting with the operation center for receiving confirmation message from the operation center to verify a payment amount requested by the registered merchant for at least a product purchased by the customer from the registered merchant, by entering a security password of the customer in the communication device for transmitting to the operation center (col. 2, lines 40-67) (claim 22);

The operation center comprises a network server for receiving the payment request from the registered merchant and a mobile server, which communicates with the network server via an Internet, for confirmation of the payment with the customer (col. 2, lines 40-67) (claim 23);

The communication terminal is connected with the operation center through a dial-up telephone line (col. 2, lines 40-67) (claim 26); and

The communication terminal is connected with the network server through a dial-up telephone line (col. 2, lines 40-67) (claim 27).

***Claim Rejections - 35 USC § 103***

Claims 10-13, 16-21, 24, 25, 28 and 29 remain and are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the Jalili patent in view of the Nessett et al. patent (US 6,055,236).

The Jalili patent discloses all the elements of the present invention, except:

The communication device is a WAP phone and further includes pushing a transaction request to the WAP phone of the customer using WAP 1.2 push architecture when the identity of the registered merchant and the transaction amount are valid (claims 10, 11, 12, 13);

The operation center comprises a network server for receiving the payment request from the registered merchant, and a mobile server, which communicates with the network server via an Internet, for confirmation of the payment with the customer and in which the network server communicates with the mobile server, and further comprising requesting the customer to confirm the transaction amount and to enter the security password of the customer, verifying the transaction amount and inputting the security password by the customer, transmitting the security password and confirmation to the network server via an Internet using IPSec protocol, scrutinizing the security password and confirmation by a firewall of the network server to make sure the security password and confirmation are authenticate, and verifying the security password of the customer by the network server of the operation center by checking the customer database thereof (claim 16);

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Issuing a final transaction receipt by the communication terminal to complete the payment transaction and printing a transaction receipt by the communication terminal to complete the payment transaction (claim 17);

The security password is a phone number of the WAP phone of the customer (claims 18 & 19);

The communication network is a WAP secured transaction layer cellular network (claims 20 & 21);

The communication device is a WAP phone communicating with the operation center via a cellular network (claims 24 & 25);

The communication terminal is connected with the operation center through a dial-up telephone line (claim 28); and

The communication terminal is connected with the network server through a dial-up telephone line (claim 29).

The Nessett patent teaches:

The communication device is a WAP phone and further includes pushing a transaction request to the WAP phone of the customer using WAP 1.2 push architecture when the identity of the registered merchant and the transaction amount are valid (Nessett, Abstract) (claims 10, 11, 12, 13);

The operation center comprises a network server for receiving the payment request from the registered merchant, and a mobile server, which communicates with the network server via an Internet, for confirmation of the payment with the customer and in which the network server



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communicates with the mobile server, and further comprising requesting the customer to confirm the transaction amount and to enter the security password of the customer (Jalili, col. 2, lines 40-67), verifying the transaction amount and inputting the security password by the customer (Jalili, col. 2, lines 40-67), transmitting the security password and confirmation to the network server via an Internet using IPSec protocol (Nessett, Abstract), scrutinizing the security password and confirmation by a firewall of the network server to make sure the security password and confirmation are authentic (Jalili, col. 3, lines 7-15), and verifying the security password of the customer by the network server of the operation center by checking the customer database thereof (Jalili, col. 2, lines 40-67) (claim 16);

Issuing a final transaction receipt by the communication terminal to complete the payment transaction (Jalili, col. 3, lines 1-6) and printing a transaction receipt by the communication terminal to complete the payment transaction (Examiner takes Official Notice that since the Jalili system identifies sending a confirmation via e-mail, it is well known in the art that e-mail messages can be printed, as such, it would have been obvious to one of ordinary skill in the art to print a receipt from the e-mail notice) (claim 17);

The security password is a phone number of the WAP phone of the customer (Jalili, col. 2, lines 40-48, and Nessett, Abstract) (claims 18 & 19); and

The communication network is a WAP secured transaction layer cellular network (Jalili, col. 2, lines 40-48, and Nessett, Abstract) (claims 20 & 21);

The communication device is a WAP phone communicating with the operation center via a cellular network (Jalili, col. 2, lines 40-67 and Nessett, Abstract) (claims 24 & 25);

The communication terminal is connected with the operation center through a dial-up telephone line (Jalili, col. 2, lines 40-57) (claim 28); and

The communication terminal is connected with the network server through a dial-up telephone line (Jalili, col. 2, lines 40-67) (claim 29).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Jalili system with the teachings of the Nessett system so as to provide a more convenient, wider reaching network (including cellular in addition to convention LAN line telephone systems) while still maintaining a secure system.

#### ***Response to Arguments***

Applicant's arguments filed 7-6-4 have been fully considered but they are not persuasive.

The Applicant states that the Jalili reference does not disclose a system wherein a customer can digitally signing back a message, however, such is considered new matter by the Examiner since it was not previously described, shown or disclosed in the specification or claims prior to the present amendment. As such, this limitation was not given any patentable weight and is not a distinguishing feature over the Jalili system. Also, just as an Examiner's note, the Nessett reference teaches the use of digital signatures within an electronic communication system.

The Applicant states that the Jalili system fails to anticipate the steps of claim 1 (page 14 of 7-6-4 Amendment, section (vii), however the Examiner has stated above such limitations are met. Applicant also takes the position that the first and second electronic networks are not equivalent to those claimed. The Examiner interprets the electronic networks of Jalili to be the

equivalent of the presently claimed invention, as identified above. Jalili even states in col. 2, lines 52-54, "the customer interacts with the processing center by some means, for example, using a telephone hand set or a computer with a modem."

The Applicant states that the Jalili patent lacks the customer indicating to the merchant that they prefer to settle a payment through a mobile payment system. However, as stated above, the customer interacts with the processing center by some means . . . [such as] a telephone hand set or a computer with a modem, both of which the Examiner considers to be mobile payment systems, as presently claimed.

The Applicant asserts the Jalili references lacks disclosing the requesting of the customer ID through a communication terminal. Again, the use of the telephone hand set or the computer are considered by the Examiner to be the equivalent of the presently claimed communication terminal.

The Applicant states that there is no suggestion to combine the references. Examiner disagrees. The Nessett patent specifically states that "[e]xternal network devices can now locate and request services, in internal network devices on internal distributed network address translation networks that were previously unavailable to the external network." (col. 5, lines 54-58). This passage of Nessett teaches that Nessett was specifically created to expand network capabilities to among and with other systems that were previously incompatible, such as wireless telephones with computer networks.

Applicant states that neither the Jalili nor the Nessett patents make any mention of using a WAP phone as a mobile communication media. Jalili was already identified as using a telephone as a mobile communication media, see discussion above, and the Nessett patent

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specifically states in col. 7, lines 50-64 that the Nessett system is for network devices that can interact with network system 10 based on certain standards. And then further identifies that the WAP standards can be found at the URL [www.wapforum.org](http://www.wapforum.org). As such, WAP technology is capable of being used in, and is taught by, the Nessett system.

For the aforesated reasons, claims 1-29 remain and are finally rejected.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600